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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/245,022	09/26/2011	Cormac O'Prey	H-US-02560	6604
50855	7590	05/02/2017		
Covidien LP 60 Middletown Avenue c/o Legal - Mailstop MS 54 North Haven, CT 06473			EXAMINER NEAL, TIMOTHY JAY	
			ART UNIT	PAPER NUMBER
			3779	
			NOTIFICATION DATE	DELIVERY MODE
			05/02/2017	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CORMAC O'PREY,
CHARLOTTE ADELE CLARK, and
ALISTAIR IAN FLEMING

Appeal 2015-007061
Application 13/245,022
Technology Center 3700

Before: CHARLES N. GREENHUT, MICHAEL L. HOELTER, and
ANNETTE R. REIMERS, *Administrative Patent Judges*.

GREENHUT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from a rejection of claims 1, 2, 4–11, 13–15, and 17–22. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

THE CLAIMED SUBJECT MATTER

The claims are directed to a cleaning apparatus configured to remove debris from the lens of a minimally invasive viewing instrument. Spec. ¶ 1. Claims 1 and 11 are independent, with claims 2, 4–10, 21, and 22 ultimately depending from claim 1, and claims 13–15 and 17–20 ultimately depending from claim 11. Br. 16–19 (claims app’x.). Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A minimally invasive surgical instrument comprising:
 - a viewing instrument including a lens and having a longitudinal axis;
 - a wiper mechanism attachable to the viewing instrument prior to introducing the viewing instrument into a body, the wiper mechanism including a pair of wipers coupled to each other by at least one connector, a first wiper of the pair of wipers configured and adapted to pivot about a second wiper of the pair of wipers as the first wiper contacts and translates diametrically across a surface of the lens, the first and second wipers having an initial position in which the first and second wipers are diametrically spaced apart with respect to the surface of the lens; and
 - an actuator positionable at a proximal portion of the viewing instrument, the actuator actuatable to move the first wiper across the lens to clean the lens.

REFERENCES

Ogawa '450	US 2002/0065450 A1	May 30, 2002
Ogawa '782	US 6,755,782 B2	June 29, 2004
Karasawa '314	JP2007105314	Apr. 26, 2007
Hsu	WO 2008/153841 A2	Dec. 18, 2008
Karasawa '753	US 2010/0225753 A1	Sept. 9, 2010

REJECTIONS

Claims 1, 2, 4, 5, 7–11, 13, 14, and 17–20 stand rejected under 35 U.S.C. § 102(b) as anticipated by Hsu. Final Act. 2.

Claims 1, 21, and 22 stand rejected under 35 U.S.C. § 102(b) as anticipated by Karasawa '314. *Id.* at 8.

Claims 1, 21, and 22 stand rejected under 35 U.S.C. § 102(b) as anticipated by Ogawa '782. *Id.* at 9.

Claims 2–4, 11–14, and 16–20 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Hsu and Karasawa '753. *Id.* at 11.

Claim 15 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Hsu, Karasawa '753 and Ogawa '450. *Id.* at 15.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Hsu and Karasawa '753. *Id.* at 16.

ANALYSIS

Rejections based on Hsu

The Examiner finds, *inter alia*, that Hsu's linear wiper 13 depicted in Figure 8 corresponds to independent claim 1's recitation of a "pair of wipers," and to claim 11's first and second substantially cylindrical members. Final Act. 2–3, 5–6 (citing Hsu, 11, 15, 16, Fig. 8). Because

Figure 8 depicts only one linear wiper, the Examiner relies on Hsu's teaching that "multiple wiper blades may be used in any embodiment." *Id.* at 3, 6; *see* Hsu, 16. The Examiner does not find that Hsu expressly teaches that the first and second wipers recited in claim 1 are "coupled to each other by at least one connector, a first wiper of the pair of wipers configured and adapted to pivot about a second wiper of the pair of wipers as the first wiper contacts and translates diametrically across a surface of the lens, the first and second wipers having an initial position in which the first and second wipers are diametrically spaced apart with respect to the surface of the lens," as claim 1 requires. Likewise, the Examiner does not find that Hsu expressly discloses claim 11's requirement that "the first substantially cylindrical member [is] pivotable with respect to the second substantially cylindrical member as the first substantially cylindrical member moves diametrically across the lens of the viewing instrument to clean the lens." Instead, the Examiner contends that "it is inherent that the wipers would be connected to either each other, or to the actuator so that movement of the actuator may be transferred to the wipers to effect cleaning of the lens." Ans. 2. The Examiner further contends that "Applicant's claimed pivot fails to describe any structural feature beyond the at least one connector, so that "[a]s the second wiper must be attached either to the actuator or the first wiper, the connection between the second wiper and the actuator or the first wiper would define a pivot because the first wiper must move or 'pivot' to function as disclosed." *Id.* at 3. Appellants respond that Hsu merely states that multiple wipers may be used, but "provides no other disclosure as to how multiple wipers would operate." Br. 6.

In relying on inherency, the Examiner must provide evidence or reasoning to establish a sound basis for the Examiner's belief that the missing descriptive matter is necessarily present in the reference. *See In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745 (Fed.Cir.1999) (citations and internal quotation marks omitted). Once the Examiner has established a sound basis for a reference's inherent disclosure, the burden shifts to Appellants to overcome, with argument or evidence, the apparent identity of Appellants' claimed device and that of the prior art. *Spada*, 911 F.2d at 708.

In the present case, we are not persuaded that the Examiner has established a sound basis for believing that the missing limitations are inherently present in Hsu. Hsu does not describe or depict an embodiment with two wipers, and does not describe how multiple wipers would be installed. Moreover, it is not necessarily the case that two wipers would be connected to each other or would pivot with respect to each other as one wiper moves across the lens. The Examiner notes that Hsu "fail[s] to teach that multiple actuators are used to actuate the wipers," and infers that Hsu would use only a single actuator, which would couple the wipers to each other. Ans. 2. But Hsu's failure to teach multiple actuators does not *necessarily* mean that multiple actuators cannot be used. Multiple wipers could each have their own actuator, in which case the wipers would not be coupled via a single actuator. Moreover, even if two wipers were connected to the same actuator, the Examiner has not explained why such connection would necessarily "define a pivot" or why "the first wiper must move or

‘pivot’ to function as disclosed.”¹ Accordingly, because we are not persuaded that Hsu’s device inherently satisfies the argued limitations, we do not sustain the Examiner rejection of claims 1 and 11, as well as dependent claims 2, 4, 5, 7–10, 13, 14, and 17–20, as anticipated by Hsu.

The Examiner relies on the same inherency rationale in rejecting as unpatentable: (1) claims 2–4, 11–14, and 16–20 over Hsu and Karasawa ’753; (2) claim 15 over Hsu, Karasawa ’753, and Ogawa ’450; and (3) claim 6 as over Hsu and Karasawa ’753. Final Act. 11–17. Because we found the Examiner’s inherency rationale unpersuasive, we also do not sustain these rejections.

Claims 1, 21, and 22—Anticipation—Karasawa ’314

The Examiner finds that Karasawa ’314 discloses all of the elements of claim 1. Final Act. 8–9 (citing Karasawa ’314, Figs. 1, 16, 18, 19). In particular, the Examiner finds that wiper members 73 correspond to the claimed pair of wipers coupled to each other by at least one connector (belt member 70), with one of the wipers 73 configured and adapted to pivot about a second wiper 73. *Id.* at 8. The Examiner contends that “the film member [belt-shaped member 70] must constantly pivot about the distal end of the endoscope in order to effect movement of the wipers (73).” *Id.* at 9.

Appellants dispute that Karasawa discloses “a first wiper of the pair of wipers configured and adapted to pivot about a second wiper of the pair of wipers as the first wiper contacts and translates diametrically across a surface of the lens,” as recited in claim 1. Br. 9. Instead, Appellants argue that Karasawa discloses “a *winding* gear 31 mounted at the sheath operation

¹ Neither the Examiner nor Appellants have offered a construction for “pivot” or “pivotable.”

part *to move the strip member 70 from one end* to the other end in the radial direction of the tip end surface.” *Id.* (quoting Karasawa, abstract).

The Examiner has not established that Karasawa ’314 anticipates claim 1. Karasawa’s top and bottom wipers 73, as viewed in Figure 16, are translating within their respective horizontal planes in a direction orthogonally with respect to the middle wiper “translat[ing] diametrically” downwardly or vertically across lens 21. The Examiner does not provide any express analysis as to the meaning of “a first wiper of the pair of wipers configured and adapted to pivot about a second wiper of the pair of wipers as the first wiper contacts and translates diametrically across a surface of the lens” so as to explain how or why this arrangement satisfies the argued limitation. It is not clear on the record before us why the Examiner considers one wiper member 73 (i.e., the middle wiper) to pivot around a second wiper member 73 (i.e., either the top or bottom wiper) as belt-shaped member 70 moves that first or middle wiper member 73 across the lens. In order for us to provide any meaningful appellate review there must be some evidence or analysis in the record to support the Examiner’s factual findings and legal conclusions. *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). A rejection must be set forth in sufficiently articulate and informative manner as to meet the notice requirement of § 132, such as by identifying where or how each limitation of the rejected claims is met by the prior art references. *In re Jung*, 637 F. 3d 1356, 1363 (Fed. Cir. 2011). It is neither our place, nor Appellants’ burden, to speculate as to the basis for rejecting claims. *In re Stepan*, 660 F. 3d 1341, 1345 (Fed. Cir. 2011) (It is the PTO’s obligation to provide timely notice to the applicant of all matters of fact and law asserted.). For these reasons, we do not sustain the Examiner’s rejection

of claim 1, as well as dependent claims 21 and 22, as anticipated by Karasawa '314.

Claims 1, 21, 22—Anticipation—Ogawa '782

The Examiner finds that Ogawa '782 discloses all of the limitations of claim 1. In particular, the Examiner finds that first and second projections 306 and 307 on wiper mechanism 301 correspond to the claimed pair of wipers, which are connected at point C. Final Act. 10 (citing Ogawa '782, 40:23–60, 41:10–24, 47:44–67, 56:35–63, Figs. 36A, 36B, 48, 51, 52A, 59). The Examiner further finds that “Applicant’s claimed pivot fails to describe any structural feature beyond the at least one connector,” and “[a]s the connector of Ogawa is configured to contain both wipers (306, 307) and is configured to move the wipers in unison about point ‘C’ it is well established that point ‘C’ is the pivot point of the wiper mechanism.” *Id.* Appellants dispute that Ogawa discloses “a first wiper of the pair of wipers configured and adapted to pivot about a second wiper of the pair of wipers as the first wiper contacts and translates diametrically across a surface of the lens,” as recited in claim 1. Br. 11.

As with the prior rejection, the Examiner has not established that Ogawa '782 anticipates claim 1. Again, the Examiner does not explain what the “pivot” limitation means, much less explain how Ogawa '782’s wipers 306 and 307 satisfy that limitation. Therefore, we do not sustain the Examiner’s rejection that claim 1, as well as dependent claims 21 and 22, are anticipated by Ogawa '782.

DECISION

For the above reasons, we reverse the Examiner's rejection of:

(1) claims 1, 2, 4, 5, 7–11, 13, 14, and 17–20 as anticipated by Hsu;
(2) claims 2–4, 11–14, and 16–20 as unpatentable over Hsu and Karasawa '753; (3) claim 15 as unpatentable over Hsu, Karasawa '753, and Ogawa '450; and (4) claim 6 as unpatentable over Hsu and Karasawa '753; (5) claims 1, 21, and 22 as anticipated by Karasawa '314 and (6) claims 1, 21, and 22 as anticipated by Ogawa '782.

REVERSED